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(For Requester)

In re Mardon, et al.  
Reexamination Proceeding  
Control No. 90/005,589  
Filed: December 14, 1999  
For: U.S. Patent No. 5,940,464

In re reissue application of  
Mardon, et al.  
Application No. 10/624,757 ✓  
Filed: July 21, 2003  
For: U.S. Patent No. 5,940,464

MAILED

APR 05 2005

REEXAM UNIT

DECISION ON  
PETITION  
TO MERGE  
REEXAMINATION  
AND REISSUE  
PROCEEDINGS

This is a decision on the July 21, 2003, patent owner petition filed under 37 C.F.R. § 1.182, requesting that either (1) the above-mentioned reexamination and reissue proceedings be merged; or (2) the reexamination proceeding be stayed/suspended in favor of the reissue application. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of \$130.00 pursuant to 37 C.F.R. § 1.17(h) for the petition under 37 C.F.R. § 1.182 has been charged to patent owner's deposit account no. 11-0600, as authorized on page 2 of the present petition.

The petition under 37 C.F.R. § 1.182 requesting that the above-mentioned reexamination and reissue proceedings be merged is dismissed for the reasons indicated below.

The alternate relief requested that the reexamination proceeding be stayed/suspended in favor of the reissue application is dismissed for the reasons indicated below.

The reissue application is stayed/suspended pursuant to 37 C.F.R. § 1.103(e) in favor of the reexamination proceeding, for the reasons indicated below.

#### REVIEW OF FACTS

1. U.S. Patent No. 5,940,464 issued to Mardon, et al., on August 17, 1999.
2. Reexamination of the '464 patent was requested by a third party requester on December 14, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,589.
3. Reexamination was denied in a decision mailed March 8, 2000, in the '5589 proceeding.
4. A petition requesting reconsideration of the denial was filed on March 31, 2000, in the '5589 proceeding.
5. A decision granting the petition and ordering reexamination was mailed in the '5589 proceeding on November 7, 2000.
6. A non-final rejection was mailed on May 24, 2001, and a response was filed on October 2, 2001, in the '5589 proceeding.

7. A final rejection was mailed on March 28, 2002, and a response to the final rejection was filed on June 28, 2002, including a proposed amendment to claim 1, in the '5589 proceeding.
8. On July 29, 2002, a Notice of Appeal was filed in the '5589 proceeding.
9. An advisory action was mailed on August 29, 2002, in the '5589 proceeding, advising the patent owner that the proposed amendment in response to the final rejection was not entered.
10. On September 30, 2002, an appeal brief was filed, and on December 18, 2002, a Notice of Defective Brief was mailed in the '5589 proceeding.
11. On January 27, 2003, an appeal brief was filed, and on May 20, 2003, an examiner's answer was mailed in the '5589 proceeding.
12. Patent owner filed a reissue application based on the '464 patent, on July 21, 2003, which was assigned Application No. 10/624,757. A preliminary amendment was included which amended claim 1.
13. Also on July 21, 2003, the present petition to merge proceedings or alternatively to stay the reexamination proceeding, was filed in the '757 reissue application.
14. On December 9, 2003, a Notice of Incomplete Application was mailed, and on February 4, 2004, a response to the notice was filed, in the '757 reissue application.
15. On April 5, 2004, the reissue application was determined to be complete.
16. Notice of the filing of the '757 reissue application was published in the *Official Gazette* on May 11, 2004.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d) :

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5589 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '5589 reexamination file shows that original claims 1-8 are pending; claims 5-8 are indicated to be patentable; and claims 1-4 stand rejected and are on appeal to the Board of Patent Appeals and Interferences (BPAI). Since the examiner's answer was mailed on May 20, 2003, and no further papers have been received in the '5589 proceeding, the issues on appeal in this reexamination proceeding are ready for consideration by the BPAI.

A review of the reissue (Application No. 10/624,757) prosecution history shows that the reissue application was published in the *Official Gazette* on May 11, 2004. In the reissue application, patent owner has amended claim 1. Therefore, the specification and claims are **not** identical in both proceedings. No Office

action has yet been mailed in the '757 reissue application.

In the reissue application filed on July 21, 2003, the patent owner appears to be presenting the same amendment to the claims that was denied entry after final rejection in the reexamination proceeding. In the reexamination proceeding, an advisory action was mailed on August 29, 2002, advising the patent owner that the proposed amendment in response to the final rejection was not entered. The examiner's reasons for denying entry of this proposed amendment indicated that the amendment to claim 1 raises the issue of new matter because the proposed narrowing language does not appear to be supported in the original patent application disclosure. It is noted that the reissue application was filed almost one year from the date of mailing of the advisory action notifying the patent owner that the proposed amendment was not entered in the reexamination proceeding.

#### DECISION

35 USC 305 states (in part):

"All reexamination proceedings under this section, including any on appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office."

The decision on whether to merge the proceedings or stay/suspend a proceeding will be made on a case-by-case basis based upon the status of the various proceedings. Due consideration will be given to the finality of the reexamination requested. In the present reexamination proceeding, claims 1-4 stand rejected and are on appeal to the BPAI, which fact is important in considering whether the proceedings should be merged, or one of them stayed. (See *In re Stoddard*, 213 USPQ 386 (Comm'r Pat. 1982); and *In re Scragg*, 215 USPQ 715 (Comm'r Pat. 1982).)

The statute directs that all reexamination proceedings, including any on appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office (emphasis added). In the present instance, the patent owner delayed in the filing of the reissue application almost one year from the date of the mailing of the advisory action notifying the patent owner that the proposed amendment was not entered in the

reexamination proceeding. The patent owner could have filed the reissue application prior to the issuance of the examiner's answer in the reexamination proceeding, but chose not to do so. As a result, the appeal in the present reexamination proceeding is ready for consideration by the BPAI. While in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, such consolidation would necessitate the reopening of prosecution in the reexamination proceeding at a point where the appeal is ready for consideration by the BPAI. Any such reopening of prosecution in the reexamination proceeding would be contrary to the special dispatch requirement set by the statute. Therefore, rather than merging the reexamination and reissue proceedings in this instance, it is instead appropriate that the reissue application be stayed/suspended. The suspension of the reissue application will prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner into the reissue application. The suspension of the reissue application will also permit the reexamination proceeding to be promptly forwarded to the BPAI for consideration of the issues on appeal, as this will provide the most efficient and prompt handling of the reexamination proceeding.

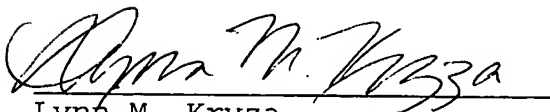
Accordingly, the petition under 37 C.F.R. § 1.182 requesting that the above-mentioned reexamination and reissue proceedings be merged is dismissed.

The alternate relief requested in the present petition that the reexamination proceeding be stayed/suspended in favor of the reissue application is dismissed. To suspend the reexamination proceeding would run counter to the statutory requirement of special dispatch. Since the reexamination proceeding is ready for consideration by the BPAI, prosecution of the reexamination proceeding will continue so that a decision by the BPAI may be promptly rendered.

The reissue application is stayed/suspended, at least until such time as a decision on the appeal in the reexamination proceeding is rendered by the BPAI. Once a decision by the BPAI on the appeal has been rendered, the reexamination and reissue files should be returned to the Office of Patent Legal Administration for reconsideration of whether the reissue application should continue to be stayed/suspended, or the reexamination and reissue proceedings should be merged at that time.

CONCLUSION

1. The petition requesting that the above-mentioned reexamination and reissue proceedings be merged is dismissed.
2. The alternate relief requested that the reexamination proceeding be stayed/suspended is dismissed.
3. The 10/624,757 reissue application is stayed/suspended, at least until such time as a decision on the appeal in the reexamination proceeding is rendered by the BPAI.
4. A copy of the instant decision will be placed in each of the above-mentioned reexamination and reissue files.
5. The 90/005,589 reexamination file is being forwarded to the Board of Patent Appeals and Interferences (BPAI) for prompt consideration of the issues on appeal.
6. Once a decision by the BPAI on the appeal has been rendered, the reexamination and reissue files should be returned to the Office of Patent Legal Administration for reconsideration of whether the reissue application should continue to be stayed/suspended, or the reexamination and reissue proceedings should be merged at that time.
7. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7722.



Lynn M. Kryza  
Senior Patent Special Projects Advisor  
Office of Patent Legal Administration

April 4, 2005